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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,111	06/27/2003	Wei Helen Li	LAA-103-US	3644

7590 05/06/2005
HENKEL LOCTITE CORPORATION
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Rocky Hill, CT 06067

EXAMINER

PIZIALI, ANDREW T

ART UNIT PAPER NUMBER

1771

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/607,111	LI ET AL.	
	Examiner	Art Unit	
	Andrew T. Piziali	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse in the reply filed on 4/11/2005 is acknowledged. In view of applicant's arguments the restriction has been withdrawn and a new restriction has been set forth.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8 and 33-35, drawn to a composition, classified in class 525, subclass 7.
 - II. Claims 9-15, 18-26, 29-32 and 36-38, drawn to a prepreg or towpreg, classified in class 428, subclass 297.4.
 - III. Claims 16-17, 27-28 and 39, drawn to a process for producing a prepreg or towpreg, classified in class 427, subclass 407.1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group I and Group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an intermediate adhesive composition layer and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In

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either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Inventions of Group I and Group III are unrelated. The process of Group III does not produce the composition of Group I.

5. Inventions of Group III and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. Exposing the heat curable composition to an elevated temperature to soften the composition and then joining the composition with the layer of fibers can make the product as claimed.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Group II further contains claims directed to the following patentably distinct species of the claimed invention:

Species Group I

Species 1 Drawn to a prepreg.

Species 2 Drawn to a towpreg.

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Species Group II

- Species 1 Drawn to a prepreg or towpreg wherein the fiber layer is made from unidirectional fibers.
- Species 2 Drawn to a prepreg or towpreg wherein the fiber layer is made from woven fibers.

Species Group III

- Species 1 Drawn to a prepreg or towpreg wherein the fiber is carbon.
- Species 2 Drawn to a prepreg or towpreg wherein the fiber is glass.
- Species 3 Drawn to a prepreg or towpreg wherein the fiber is aramid.
- Species 4 Drawn to a prepreg or towpreg wherein the fiber is boron.
- Species 5 Drawn to a prepreg or towpreg wherein the fiber is polyalkylene.
- Species 6 Drawn to a prepreg or towpreg wherein the fiber is quartz.
- Species 7 Drawn to a prepreg or towpreg wherein the fiber is polybenzimidazole.
- Species 8 Drawn to a prepreg or towpreg wherein the fiber is polyetheretherketone.
- Species 9 Drawn to a prepreg or towpreg wherein the fiber is polyphenylene sulfide.
- Species 10 Drawn to a prepreg or towpreg wherein the fiber is poly p-phenylene benzobisoxazole.
- Species 11 Drawn to a prepreg or towpreg wherein the fiber is silicon carbide.
- Species 12 Drawn to a prepreg or towpreg wherein the fiber is phenolformaldehyde.
- Species 13 Drawn to a prepreg or towpreg wherein the fiber is phthalate.
- Species 14 Drawn to a prepreg or towpreg wherein the fiber is naphthenoate.

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Species Group IV

- Species 1 Drawn to a prepreg or towpreg wherein the glass is S glass.
- Species 2 Drawn to a prepreg or towpreg wherein the glass is S2 glass.
- Species 3 Drawn to a prepreg or towpreg wherein the glass is E glass.
- Species 4 Drawn to a prepreg or towpreg wherein the glass is R glass.
- Species 5 Drawn to a prepreg or towpreg wherein the glass is A glass.
- Species 6 Drawn to a prepreg or towpreg wherein the glass is AR glass.
- Species 7 Drawn to a prepreg or towpreg wherein the glass is C glass.
- Species 8 Drawn to a prepreg or towpreg wherein the glass is D glass.
- Species 9 Drawn to a prepreg or towpreg wherein the glass is ECR glass.
- Species 10 Drawn to a prepreg or towpreg wherein the glass is glass filament.
- Species 11 Drawn to a prepreg or towpreg wherein the glass is staple glass.
- Species 12 Drawn to a prepreg or towpreg wherein the glass is T glass.
- Species 13 Drawn to a prepreg or towpreg wherein the glass is zirconium oxide glass.

Species Group V

- Species 1 Drawn to a prepreg or towpreg wherein the carbon is polyacrylonitrile.
- Species 2 Drawn to a prepreg or towpreg wherein the carbon is pitch.
- Species 3 Drawn to a prepreg or towpreg wherein the carbon is acrylic.

8. Therefore, upon the election of Group II, the applicant is further required under 35 U.S.C. 121 to elect a single disclosed species (from each of Species Groups I-V) for prosecution

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on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Due to the complexity of the restriction requirement, a telephone call was not made to applicant's representative to request an oral election to the above restriction requirement.

13. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

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14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

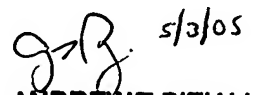
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp


ANDREW T. PIZIALI
PATENT EXAMINER